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OCT 26 2006

OFFICE OF PETITIONS

In re Application of	:
Chauvel et al.	:
U.S. Patent No.: 7,028,145	:
Issue Date: April 11, 2006	: Decision on Petition for
Application No. 08/890,894	: Patent Term Extension
Filed: July 10, 1997	:
Attorney Docket No. TIF-15767A	:
For: Protocol Processor Intended For The	:
Execution Of A Collection Of Instructions In	:
A Reduced Number Of Operations	:

The above-identified application has been forwarded to the undersigned for consideration on the "Petition For Extension Of Patent Term Due To Examination Delay - 37 CFR 1.181," which was received on April 17, 2006, for the above-identified application. See 35 U.S.C. § 154(b) and 37 CFR 1.701.

The petition is dismissed.

Petitioner notes that the above-identified application was filed on July 10, 1997, a Notice of Appeal was filed on October 7, 2002 and the Board of Patent Appeals and Interferences (BPAI) remanded the application to the Examiner on August 10, 2004. Petitioner argues that first and second Notice of Allowance and Issue Fees mailed on June 1, 2005 and October 11, 2005, both improperly failed to include a patent term extension of 769 days.

Petitioner states that the application was filed after June 8, 1995 but before May 29, 2000 and that the present application is not subject to a terminal disclaimer, thus the patent is entitled to patent term extension. Petitioner asserts that had the BPAI not remanded the application to the Examiner, the BPAI would have reversed the Examiner entitling the application to patent term extension. Petitioner asserts that the application should be entitled to 769 day of patent term extension.

35 U.S.C. 154. Contents and term of patent (in effect on June 8, 1995)
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(b) TERM EXTENSION.-

(1) INTERFERENCE DELAY OR SECRECY ORDERS.-If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is

placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.
(2) EXTENSION FOR APPELLATE REVIEW.-If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000. 35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

The above-identified application was filed on July 10, 1997, which is after June 8, 1995 and before May 29, 2000, and, as a result is an application that may be eligible for patent term extension under 35 U.S.C. § 154. While the application was issued pursuant to a remand by the BPAI, the application is subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct.

While Petitioner states, "the present application is not subject to a terminal disclaimer," Petitioner, Ronald O. Neerings on June 30, 2000, filed a terminal disclaimer. The terminal disclaimer states that it was filed to obviate a double patenting rejection, listed the prior U.S. Patent No, was signed by a proper party, authorized payment of the fee and the fee was charged. The terminal disclaimer was filed in response to two double patenting rejections made in the final rejection mailed on January 19, 2000. The double patenting rejections was withdrawn by the examiner in response to the terminal disclaimer in the Advisory Action mailed on July 28, 2000. While the terminal disclaimer, previously submitted by Petitioner, was not fully treated by the Office, the terminal disclaimer was matched with the above-identified application, the fee was charged, and the Examiner withdrew the double patenting rejection in response to the terminal disclaimer. Since the disclaimer was filed and complied with the meaning of § 253, and since nothing in the statutes or regulations requires treatment or any further action by the Office, the disclaimer was effective when filed and the patent issued. See *Vectra Fitness Inc. v. TNWK Corp.*, 49 USPQ2d 1144 (Fed. Cir. 1998). The terminal disclaimer has now been more completely treated by the Office, however this does not affect its earlier effectiveness.

Under 37 CFR 1.701(a)(3), the patent is not entitled to patent term extension because the patent is subject to a "terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct . . .." The statute § 154(b)(2) states that a "patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review" and the patent that issued is subject to a terminal disclaimer.

The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

After mailing of this decision, the above-identified application will be returned to the Files Repository.

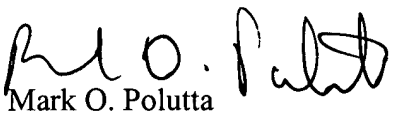
The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). Petitioner's deposit account has not been charged a petition fee. [1]

Further correspondence with respect to this matter should be addressed as follows:

By fax: Attn: Patent Term Extension Reply
(571) 273-8300

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The petition has been treated under 37 CFR 1.181 in this instance and 37 CFR 1.701 does not provide for patent term extension in this situation. If Petitioner desires review under 37 CFR 1.182 or 37 CFR 1.183, he should provide a rational for such a petition and the required petition fee.